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TECHNOLOGY CENTER R3700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants : Hilicki et al.
Application No. : 09/606,426
Confirmation No. : 6100
Filed : June 28, 2000
For : COIN DISPLAYING BOOK
Examiner : Mark T. Henderson
Group Art Unit : 3722

Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

New York, New York 10020
February 24, 2003

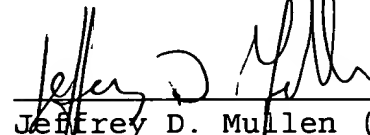
TRANSMITTAL LETTER FOR REPLY BRIEF
PURSUANT TO 37 CFR § 1.193(b)

Sir:

Transmitted herewith is a Reply Brief to be filed in
the above-identified patent application.

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Respectfully submitted,



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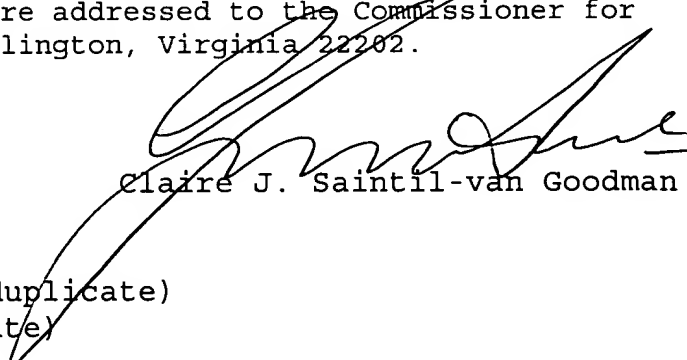
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Claire J. Saintil-van Goodman

Transmittal letter (in duplicate)
Reply Brief (in triplicate)
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Commissioner for Patents
P.O. Box 2327
Arlington, Virginia 22202

New York, New York 10020
February 24, 2003

REPLY BRIEF

Sir:

Applicants/Appellants are filing this Reply Brief, in triplicate, pursuant to 37 C.F.R. § 1.193(b) in response to the Examiner's Answer dated December 24, 2002.

Introduction

Claims 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63, and 65-68 were rejected under 35 U.S.C. § 103(a) based on ISBN. This rejection was set forth in the Final Office Action dated

April 18, 2002. Applicants/Appellants filed an Appeal Brief on October 17, 2002. This Reply Brief includes a restatement of portions of the Examiner's Answer followed by applicants'/appellants' comments thereon.

REMARKS

Claims 1-6, 8, 10-33, 35, 37, 40-58, 60, 62, 63

Applicants'/appellants' invention, which is variously defined by the pending claims on appeal as a coin display book (claims 1-6, 8, 10-33, 35, 37, and 39-43) and method for making a coin display book (claims 44-58, 60, 61, 63, and 65-68.) The book according to the invention having a cover, the exterior of the cover that defines one or more coin receivable apertures.

In the Examiner's Answer, the Examiner alleged the following:

"It would have been obvious ... to place an aperture at any desirable location on the cover, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70."
Examiner's Answer, Page 4.

In re Japikse states that there is no invention in shifting a component to a different position when "the operation of the device would not thereby be modified" (*Id.*

at 73). However, the operation of applicants'/appellants' claimed coin book would be modified if the coin receivable apertures were moved from the interior of a cover to the exterior of one. Particularly, applicants'/appellants' coin display book does not have to be opened in order to add, remove, store, or manipulate coins as required by ISBN. As a result, the functional operation of applicants'/appellants' invention is different from ISBN. The property of storing coin on the exterior of the book is not discussed by ISBN or the prior art.

As states in the Appeal Brief, the Examiner may have overlooked a critical element from the *In re Japikse* holding. Specifically, the Examiner states that "rearranging parts of an invention involves only routine skill in the art." This cited quote is misleading because it was not made by the Appeal Board, but by the Primary Examiner during prosecution of the case. Particularly, the Primary Examiner in *In re Japikse* states that "the relocation of Cannon's switch A-42 so that it may be operated by beaver tale 62 instead of by dog A-2 is devoid of invention" (*In re Japikse*, 86 USPQ 74).

The Appeal Board, however, held that "there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified" (*In re Japikse*, 86

USPQ 73). For this reason, the Appeal Board holds that if the operation of a device is modified by shifting one or more of its components, then a unique and novel invention would exist.

According to the principles of *In re Japikse*, if the operation of a coin book changes as a result of a shifting of these coin receivable apertures then a unique and novel invention would exist. Moving the apertures to the exterior of the cover eliminates the need for opening the book in order to view, add, remove, store, and manipulate the coins. Thus, this claimed element distinguishes the operation of applicants' coin display book from the prior art. The coins may be seen without opening the coin book and may provide insight into the theme of the pre-printed information of the book.

The Examiner also alleged, in the Examiner's Answer, the following:

"... the prior art does not state that the coin book is used specifically as a 'storage device'. Since the [prior art] coin book contains descriptive display material on the book as well as on the interior pages, one must conclude that this book's purpose is to display coins and a theme supporting the coins. By placing apertures and coins on the exterior of the cover, the cover's marketability is only further enhanced, as well as enticing for an observer to open the cover and review the material inside. Furthermore, operation of the device (display device) would not be modified, since shifting of the apertures and coins from the interior to the exterior only enhances the

display, and the function of the book would be the same." Examiner's Answer, Page 4.

Applicants'/appellants' assert that the enhanced marketability, as conceded to by the Examiner, is attributed to the novel storage capabilities of applicants'/appellants' claimed invention. Thus, the Examiner concedes to the patentability of an exterior coin aperture when the Examiner concedes to an enhanced marketability because this marketability is directly attributable to the structure of applicants'/appellants' claimed invention.

The operation in storing a coin in applicants'/appellants' claimed exterior coin apertures is functionally, operationally, and distinctly different than ISBN's interior coin apertures. For a coin to be stored in applicants'/appellants' exterior coin receivable aperture, a coin simply has to be placed in the exterior coin receivable aperture. Applicants'/Appellants' book does not have to be opened. As a trade off to this added functionality, no protection is provided to the displayed side of applicants'/appellants' coin. However, ISBN provides protection to both sides of the coins that are stored therein when ISBN is closed. However, as a trade off with respect to the ISBN device, ISBN does not allow a user to store a coin without the user having to open the ISBN device. Thus, a user

does not have the ability to see or store coins in ISBN unless ISBN is open.

The Examiner further alleged the following:

"appellants' statement that 'applicant/appellants' coin display does not have to be opened in order to add, remove, or manipulate coins', leads one to conclude that appellants' invention is used more for storage purposes than displaying."
Examiner's Answer, Page 4.

As stated above, applicants'/appellants' claimed exterior apertures provides a different functionality/operation than ISBN's interior coin apertures. As the Examiner concedes above, applicants'/appellants' invention provides additional storage capabilities than ISBN by providing the novel property of external coin storage. These storage capabilities are different from ISBN's storage capabilities in that applicants'/appellants' exterior coin aperture is primarily used to display a coin and make that coin more accessible to a user even when applicants'/appellants' book is closed. The storage capabilities of ISBN's interior coin apertures can only be used as a protection device when ISBN is closed.

The Examiner further alleged the following:

"the Examiner submits that the prior art does suggest the desirability of the modification, since the display indicia on the front cover, the back cover, the spine cover and the interior pages entices a user to peruse through the display book.

Any additional features only add to the display effect."

The Examiner concedes that applicants'/appellants' claimed exterior coin receivable apertures increases the display effect of a book. Because this display effect is directly associated to the storage ability (e.g., functionality) and the structure of applicants'/appellants' claimed invention, applicants/appellants respectfully submit that the Examiner concedes to the patentability of the claims at issue. Applicants/Appellants respectfully submit that the increased display effect is attributed to the novel structure that allows a user to store coins on the exterior of what would otherwise be an ordinary book or coin-protecting device.

The Examiner also alleged that "such modifications would produce no new or unexpected results" and that the prior art suggests the desirability of the modification.

Applicants/Appellants have given the Examiner, not one, but two opportunities to conduct prior art searches by filing an Request for Continued Examination on November 11, 2002. With over a hundred years of numerous coin storage and coin display innovations, the Examiner has not found any prior art books that include applicants/appellants' exterior coin receivable apertures. The Examiner has also, presumably, searched for publications since ISBN was submitted by the Examiner as prior art.


Applicants/Appellants submit that the sheer number of coin collecting and coin display systems that have been disclosed is evidence that applicants'/appellants' modification, even if the modification is only thought of as rearranging the location of a coin-receivable aperture, is non-obviousness, patentable, and produces an unexpected, useful, and distinguishably new result.

Furthermore, the differences between the storage capabilities of prior art coin displays are minimal. Moreover, prior art coin holders are typically not directed at the storage of a coin, but the presentation of it (e.g., ISBN discusses a map with coin-receivable apertures). Applicants'/Appellants' coin receivable aperture does not only promote the field of coin storage books by providing a new medium on which they can be displayed (e.g., an ordinary book), but applicants'/appellants' coin receivable apertures also provide a new and novel storage capability.

Conclusion

Applicants/Appellants have demonstrated that claims 1-6, 8, 10-33, 35, 37, 40-58, 60, 61, 63, and 65-68 are in condition for allowance. The Examiner's rejections of these claims should be reversed.

Respectfully submitted,



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